



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Charles J. Rizzo et al.
Serial No. : 10/713,428
Filed : November 17, 2003
Title : MAGNETIC ADVERTISEMENT

Art Unit : 3611
Examiner : J. Silbermann

Commissioner for Patents
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Washington, D.C. 20231

BRIEF FOR APPELLANT

Further to the Notice of Appeal filed October 14, 2005, Applicant respectfully submits this brief in support of the appeal of the Examiner's Final rejection dated June 14, 2005, rejecting claims 1-30 and 32.

The fee for this Appeal Brief under 37 CFR § 41.20(b)(2) is \$250.00.

A check in the amount of \$250.00 for the fee is enclosed.

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I. REAL PARTY IN INTEREST

Magna Card, Inc. of Owing Mills, MD.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 1-30, 32, 33, and 36-49 are pending. Claims 31, 34, and 35 have been cancelled. Claims 33 and 36-49 have been withdrawn from consideration by the Examiner. Claims 1-30 and 32 are rejected and are now on appeal.

IV. STATUS OF AMENDMENTS

No amendments after final have been submitted. The last amendment dated March 10, 2005 was entered by the Examiner and considered prior to the final office action of June 14, 2005. The Appendix of Claims reflects the amendment and status of the claims as of March 10, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Applicant's claimed subject matter is generally directed to user customizable, magnetic advertisements. According to the claimed invention, businesses may customize magnetic advertisements by affixing their current business information to a magnet using, for example, a business card.

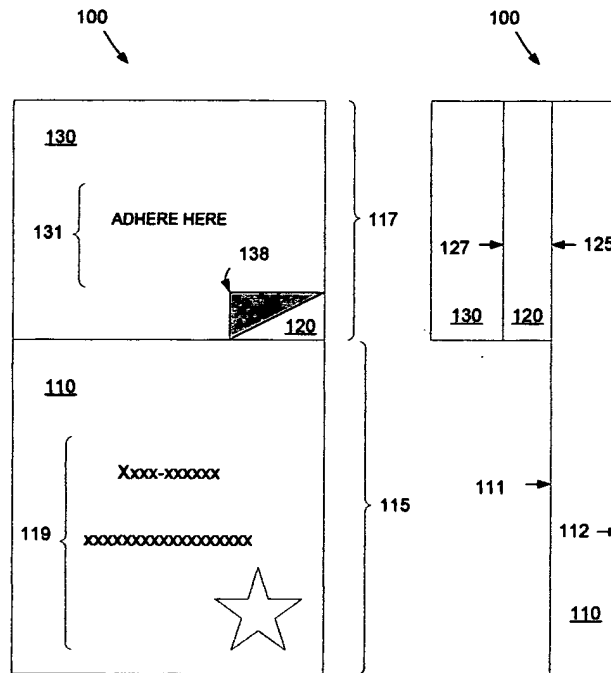


FIG. 1

FIG. 2

Figs. 1 and 2 and corresponding pages 6-8 of the specification show an implementation of a magnetic advertisement 100. As recited in claims 1 and 17, The "magnetic advertisement" 100 includes a "layer" 110 that may be made using a magnetic material (e.g., a rubber or polymer including a number of ferromagnetic or magnetized particles). The layer 110 may include a "first surface" 111 and a "second surface" 112. As shown in Fig. 1, the first surface 111 may be divided into two "portions" 115 and 117. The "second portion" 115 may include "information related to a business" 119. Figs. 5 and 6 show examples information 119 in the form of a coupon and service reminder, respectively.

The claimed "first portion" 117 of the first surface 111 is configured to customize the advertisement 100 by a user. As recited in claims 1 and 17, the first portion 117 may include a

“first dimension” and a “second dimension” forming a “two dimensional rectangular shape substantially the size of a business card.” An “adhesive” 120 may be “affixed to the first portion” 117 of the first surface 111 having dimensions “substantially similar to the first portion” and “configured to receive the business card.”

The adhesive 120 may be covered by a “protective layer” 130, such as, for example, release paper. The layer 130 protects the adhesive 120 from contamination or premature bonding. The protective layer 130 is removed to provide access to the adhesive 120 in order to customize the advertisement 100 by “affixing the business card.” The user customized magnetic advertisement may be displayed by placing the second surface 112 of layer 110 in contact with a surface receptive to magnets (e.g., a surface containing iron).

As recited in claim 3, the second portion 115 may be a “coupon” 510 an example of which is shown in Fig. 5. The coupon 510 is described at page 10 of the specification is redeemed by the customer according to the terms of the coupon 510. The coupon 510 may be removed or detached from the advertisement 100. Since the coupon 510 is magnetized, the chances are improved that the coupon 510 will not be lost by the customer once applied to a surface, such as, for example, an appliance (e.g., refrigerator, microwave, dishwasher, washing machine, furnace) office furniture (e.g., a file cabinet) or a door. In addition, the visibility/accessibility of the coupon 510 is increased, resulting in a higher probability of use by the customer (and thereby increasing business).



FIG. 5

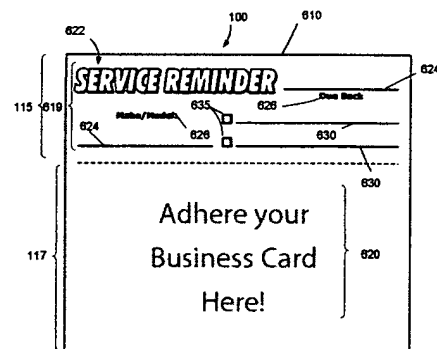


FIG. 6

The second portion 115 also may be a “service reminder” 610 and example of which is shown in Fig. 6 and recited in claim 5, or an “appointment reminder” as recited in claim 6 and described at the paragraph bridging pages 11 and 12 of the specification which is used to remind

a user of required services (e.g., car or furnace service) or appointments (e.g., doctor or dentist). Since the reminder is magnetized, the chance of losing the reminder is reduced. In addition, the visibility/accessibility of the reminder is increased, resulting in a higher probability the customer/client will make the appointment or obtain recommended services (and thereby increase business).

The user customizable magnetic advertisement allows small businesses to minimize costs associated with magnetic advertisements by allowing the business to keep a sufficient inventory of the magnetic advertisements on hand to meet demand without fear that the existing, undistributed stock of magnetic advertisements would be rendered obsolete if the business's information changes. As a result, the business does not waste the unused magnetic advertisements (e.g., as would be the case with magnetic advertisements with preprinted business contact information) and may keep larger inventories on hand to avoid shortages. In addition, the magnetic advertisements are easy to use, require no special training or equipment by the user to make them, and may be customized anywhere while providing an advertisement that has a professional finished appearance.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection on appeal are whether claims 1-30 and 32 are upatentable under 35 U.S.C. 103 as obvious over U.S. Patent No. 6,347,469 to Huellinghoff et al. ("Huellinghoff") in view of U.S. Patent No. 5,680,709 to Stone ("Stone").

VII. ARGUMENT

A. Claims 1-30 and 32 recite features that are neither described nor suggested by Huellinghoff or Stone, and one of ordinary skill in the art would not have been motivated to modify Huellinghoff in view of Stone to supply the missing features.

Independent Claim 1 recites:

A user customizable, magnetic advertisement for a business comprising:

a first magnetic layer having a first surface and a second surface wherein the first surface is divided into

a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card;

a second portion including information related to the business;

an adhesive affixed to the first portion having first and second dimensions substantially similar to the first portion and configured to receive the business card; and

a protective layer affixed to the adhesive which may be removed to receive the business card,

wherein the advertisement is customizable by removing the protective layer and affixing the business card.

Independent Claim 17 recites:

A user customized magnetic advertisement for a business comprising:

a first magnetic layer having a first surface and a second surface, the first surface further comprising:

a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card;

an adhesive affixed to the first portion; and configured to receive and affix the business card to the adhesive;

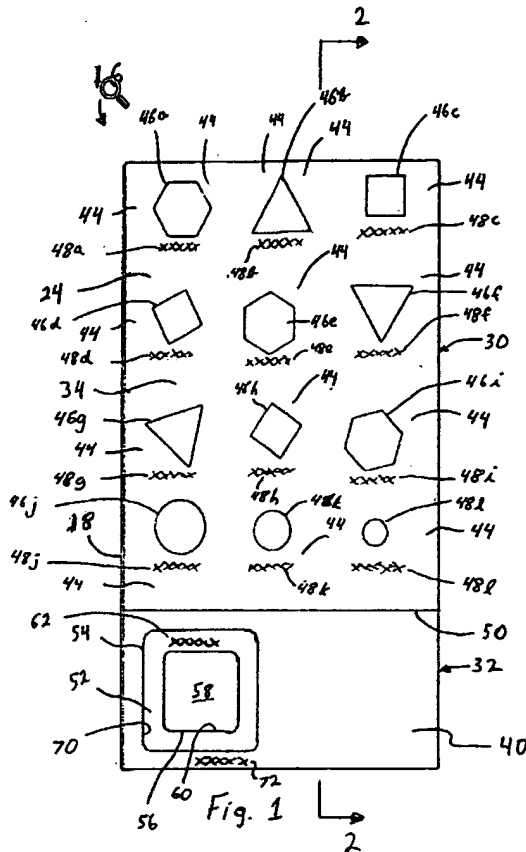
a second portion having a first dimension that is substantially similar to the first dimension of the first portion and including information related to the business,

such that when the business card is affixed to the first portion, the customized magnetic advertisement presented by the first and second portions has a professional, finished appearance.

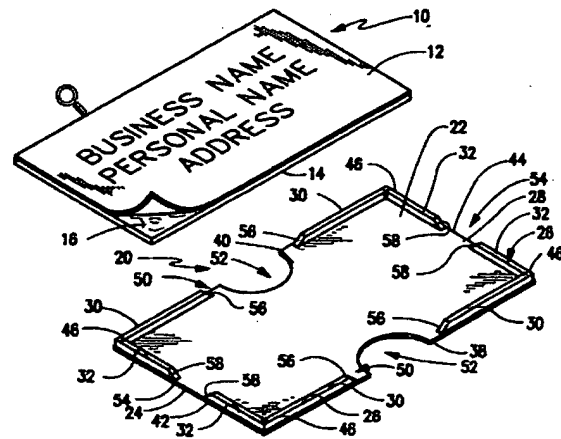
Examiner's Rejection of Claims 1 and 17

The examiner applies Huellinghoff in view of Stone to assert the subject matter of claims 1 and 17 are obvious. Huellinghoff describes a magnetic display 16 that includes a message sheet 18 as shown in Fig. 1 below. The message sheet 18 includes a message section 30 and a frame section 32. The message section 30 includes a plurality of discrete regions 44 having a printed message. The printed message may include a pictorial portion and a worded portion. The frame section 32 may be separated from the message section 30 along a line of weakness 50. The purpose of the frame section 30 is to secure a frame member 52 having a window 60 to the message sheet presumably until the message sheet is used. The frame member 52 may be separated from the frame section 32. After separation of the frame member 52 the frame section may be discarded. The frame member 52 is magnetically attracted to the message section 30 and may be placed on the message section 30 such that the window 60 frames a message of the discrete region 44. The frame member 52 may include a worded phrase that when combined with the printed message of the discrete section 44 appearing in the window 60 creates a sentence (e.g., "I am" combined with and framing "out to lunch")¹. In a separate embodiment the frame member 52 may be left attached to the message section 32 to frame a picture using the opening 70.

¹ See Huellinghoff Fig. 1 and col. 3, lines 22-41.



Huellinghoff Fig. 1



Stone Figs. 1 and 2

Stone, as shown in Figs. 1 and 2 above, describes an alignment device 20 to align a display panel 12 (e.g., a business card) on a magnetic backing panel 14 that is provided with an adhesive 16. The alignment device 20 includes walls 30 and 32. The display panel 12 and magnetic backing panel 14 are aligned when placed within the walls 30 and 32.

In her rejection, the Examiner equates the magnetic display 16 of Huellinghoff with Applicant's magnetic advertisement 100. Applicant's claimed first portion 117 is equated with the message section 30 and Applicant's claimed second portion 115 is equated with frame section 32. However, Huellinghoff does not describe or suggest that:

1) the first portion has "a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card";

2) an adhesive affixed to the first portion having first and second dimensions substantially similar to the first portion and configured to receive the business card;

3) a protective layer affixed to the adhesive which may be removed to receive the business card;

4) wherein the advertisement is customizable by removing the protective layer and affixing the business card.

The Examiner points out that Stone teaches "that it is old and well know to apply a display such as a business card to a magnetic backing by using adhesive . . . and a protective sheet over the adhesive," and that "It would have been obvious to a person having ordinary skill in the art to utilize the personalized message of Stone on the display of Huellinghoff et al. so that the message portion of the display may be personalized." The Examiner goes on to state that "Huellinghoff et al. and Stone do not specify the particular shape or dimensions of the display, however it would have been obvious to one of ordinary skill in the art to utilize a first surface large (or small) enough to accommodate a desired display. Also, matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re SEID*, 73USPQ431 (CCPA1947)."

Errors in the Rejection of claims 1, 2, 4, 5, 8-18, 20, 21, 24-30 and 32

To establish a *prima facie* case of obviousness, three basic criteria must be met:

1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988);

2) there must be a reasonable expectation of success, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991);

3) the prior art references when combined must teach or suggest all the claim limitations *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

It is well established that regardless of whether references can be combined or modified, the resultant combination is not rendered obvious unless there is a motivation to combine. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.) and *In re Fritch*,

972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). However, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Similarly, the proposed modification or combination of the prior art may not change the principle of operation of the prior art invention being modified and render a *prima facie* case of obvious with regard to Applicant's claims. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

An intended purpose of the message board described in Huellinghoff is to allow a user to display different messages by positioning the frame 52 over a discrete message region 44.² The Examiner's rejection asserts that it would have been obvious to utilize the personalized message of Stone by placing the display panel 12 on the message section 32 of Huellinghoff so that the message section 32 may be personalized. However, in order to meet the limitations of claims 1 and 17, the message section of 32 of Huellinghoff (equated with Applicant's first portion 117) must be the same size as the display panel 12 of Stone (equated with a business card) as claims 1 and 17 recite "a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card"

However, if the display panel 12 (i.e., a business card) of Stone were combined with the message section 32 of Huellinghoff, and both the display panel 12 and the message panel have the substantially same dimensions, all of the discrete message regions 44 of Huellinghoff would be covered rendering them useless.³ Furthermore, once Huellinghoff and Stone are combined in a way that meets Applicant's claimed limitations, the use of Huellinghoff's frame 52 (used to outline a message region 44 to create a complete message) would also be rendered useless as the messages would be covered by the display panel 12 (in addition to the window 60 of the frame 52 being smaller than the display panel 12) and thereby change the principle operation of

² (See, e.g., Huellinghoff col. 2 lines 4-12).

³ Note, if the display panel 12 and the message section 32 do not have substantially the same dimensions, then the resulting combination of Huellinghoff and Stone does provide Applicant's claimed structure and fails to teach all the claim limitations thereby failing the third prong of a *prima facie* case of obviousness given above. Furthermore, these dimensions are not trivial, as they are provided to align the business card with the magnetic advertisement and provide a professional, finished appearance that is found in advertisements that are preprinted with the business information (a professional, finished appearance being important to promoting one's business and the purpose of an advertisement in the first place).

Huellinghoff. Similarly, there is no description or suggestion for forming an adhesive 16 of Stone over substantially the entire message section 32 as this would interfere with the use of the frame 52 and would cover the discrete regions 44 and their messages. As a result, the proposed combination of Huellinghoff and Stone would render Huellinghoff unfit for its intended use or purpose. Therefore, Huellinghoff and Stone do not render claim 1 as obvious as there is no motivation to combine the documents.

In the Examiner's previous response to Applicant's arguments the Examiner states "Applicant argues that the combination taught by the references would not result in Applicant's invention because the dimensions of the device would be different and because the display panel and the message section would be the same size. As discussed in the above rejection, the size of the display device would have been obvious to one of ordinary skill. Also, a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955)." However, regardless of the level of skill in the art involved, even if Huellinghoff and Stone were combined, in order to meet Applicant's claimed limitations, the display portion 12 and the message section 32 would have to have substantially the same dimensions. The resulting combination would render Huellinghoff unsatisfactory for its intended purpose. As result, there is no suggestion or motivation to make the proposed modification as required by the first prong noted above of establishing a *prima facie* case of obviousness. Therefore, the Examiner's rejection is erroneous since she has failed to establish a *prima facie* case of obviousness with regard to combining Huellinghoff and Stone, and the Examiner's rejection should be reversed.

Dependent claims 3, 6, 7, 19, 22, and 23

Claims 3 and 19, 6 and 22, and 7 and 23, recite that the second portion of the first layer is a coupon, a service reminder, or an appointment reminder, respectively.

Examiner's Rejection of Claims 3, 6, 7, 19, 22, and 23

In her rejection of claims 3, 6, 7, 19, 22, and 23, the Examiners states that "Huellinghoff et al. and Stone do not teach the display as being a coupon, or having a date and time etc. However, the particular type of indicia on the display appears to be entirely a matter of design

choice. Applicant's claims have been carefully considered and there does not appear to be any new and unobvious functional relationship between the printed matter and the substrate.” The examiner goes on to state, “It would have been obvious to one of ordinary skill in the art to utilize any indicia needed to convey the desired message. Additionally, patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure.”

Errors in the Rejection of claims 3, 6, 7, 19, 22, and 23

The Examiner's rejection correctly identifies that neither Huellinghoff, nor Stone describe or suggest the use of a coupon, a service reminder, or an appointment reminder. However, the Examiner dismisses the limitations of Applicant's claims 3, 6, 7, 19, 22, and 23 as mere design choice. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). If a limitation is not taught, the Examiner must provide a motivation to modify Huellinghoff to provide the missing claimed limitations. The examiner has not satisfied this burden and therefore has not established a *prima facie* case of obviousness with regard to Applicant's claims. As a result, the Examiner's rejection should be reversed.

In addition, the claims do not recite “printed matter” as asserted by the Examiner, but rather refer to a combination of physical entities, e.g., a user customizable display and a coupon. The Examiner states “there does not appear to be any new and unobvious functional relationship between the printed matter and the substrate;” however, this ignores the functional relationship provided between Applicant's recited first and second portions, for example, providing a display of the a business information in combination with a second portion that providing a discount or a reminder that a customer would find useful thereby increasing the odds that the customer would use the advertisement⁴ and return to or use the business in the future. It is the display of both of these portions, in combination and relation to each other (in addition to the customizability of the magnetic advertisement), that provides a beneficial display for a business.

⁴ Rather than discarding it, for example.

VIII. CONCLUSION

For all the forgoing reasons, it is respectfully submitted that the rejection of claims 1-30 and 32 is erroneous, and reversal of the rejection is respectfully requested.

Respectfully submitted,

Law Office of Andrew Bodendorf, LLC

Date: FEBRUARY 14, 2006



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CLAIMS APPENDIX

1. A user customizable, magnetic advertisement for a business comprising:
 - a first magnetic layer having a first surface and a second surface wherein the first surface is divided into
 - a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card;
 - a second portion including information related to the business;
 - an adhesive affixed to the first portion having first and second dimensions substantially similar to the first portion and configured to receive the business card; and
 - a protective layer affixed to the adhesive which may be removed to receive the business card,wherein the advertisement is customizable by removing the protective layer and affixing the business card.
2. The magnetic advertisement of claim 1 wherein the second portion has a substantially triangular shape having a base abutting the first portion.
3. The magnetic advertisement of claim 1 wherein the second portion is a coupon.
4. The magnetic advertisement of claim 1 wherein the first layer includes a boundary between the first portion and the second portion, the boundary included one of perforations, indentations, or scoring to aid in the separation of the first portion from the second portion.
5. The magnetic advertisement of claim 1 wherein the second portion has a first dimension that is substantially similar to the first dimension of the first portion, such that when the business card is affixed to the first portion the overall magnetic advertisement presented by the first and second portions has a professional, finished appearance.

6. The magnetic advertisement of claim 1 wherein the second portion includes a service reminder.
7. The magnetic advertisement of claim 1 wherein the second portion includes an appointment reminder.
8. The magnetic advertisement of claim 1 wherein the second portion includes a tag line including information about a business.
9. The magnetic advertisement of claim 1 wherein the second portion is configured to receive written indications.
10. The magnetic advertisement of claim 1 wherein the second portion further comprises designated areas to receive written information.
11. The magnetic advertisement of claim 10 wherein the written information includes one of an appointment, a date and a time.
12. The magnetic advertisement of claim 10 wherein the written information includes a service to be performed.
13. The magnetic advertisement of claim 10 wherein the written information includes one of a make, a model, and one or more services to be performed on a vehicle.
14. The magnetic advertisement of claim 1 wherein the second surface is configured for placement on a magnetic receptive material to display the advertisement.
15. The magnetic advertisement of claim 2 wherein the dimension of the base is greater than the first dimension of the first portion.

16. The magnetic advertisement of claim 1 wherein the first and second dimensions of the first portion of the first surface are substantially three and a half inches by two inches.

17. A user customized magnetic advertisement for a business comprising:

a first magnetic layer having a first surface and a second surface, the first surface further comprising:

a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card;

an adhesive affixed to the first portion; and configured to receive and affix the business card to the adhesive;

a second portion having a first dimension that is substantially similar to the first dimension of the first portion and including information related to the business,

such that when the business card is affixed to the first portion, the customized magnetic advertisement presented by the first and second portions has a professional, finished appearance.

18. The magnetic advertisement of claim 17 wherein the adhesive has first and second dimensions substantially similar to the first portion.

19. The magnetic advertisement of claim 17 wherein the second portion is a coupon.

20. The magnetic advertisement of claim 17 wherein the first layer includes a boundary between the first portion and the second portion, the boundary included one of perforations, indentations, or scoring to aid in the separation of the first portion from the second portion.

21. The magnetic advertisement of claim 17 wherein the second portion includes a frequent purchase coupon.

22. The magnetic advertisement of claim 17 wherein the second portion includes a service reminder.
23. The magnetic advertisement of claim 17 wherein the second portion includes an appointment reminder.
24. The magnetic advertisement of claim 17 wherein the second portion includes a tag line including information about the business.
25. The magnetic advertisement of claim 17 wherein the second portion is configured to receive written indications.
26. The magnetic advertisement of claim 17 wherein the second portion further comprises designated areas to receive written information.
27. The magnetic advertisement of claim 26 wherein the written information includes one of an appointment, a date and a time.
28. The magnetic advertisement of claim 26 wherein the written information includes a service to be performed.
29. The magnetic advertisement of claim 26 wherein the written information includes one of a make, a model, and one or more services to be performed on a vehicle.
30. The magnetic advertisement of claim 17 wherein the second surface is configured for placement on a magnetic receptive material to display the advertisement.
31. (Cancelled)

32. The magnetic advertisement of claim 17 wherein the first and second dimensions of the first portion of the first surface are substantially three and a half inches by two inches.

33. A method of customizing a magnetic advertisement for a business, the method comprising:
providing a magnetic layer including a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card with an adhesive and a protective layer covering the adhesive and second portion having a first dimension that is substantially similar to the first dimension of the first portion including information relating to the business;

removing the protective layer to expose the adhesive;

affixing a business card, having a first dimension and a second dimension substantially similar to the first and second dimensions of the first portion, to the adhesive where the first dimension of the first portion, the first dimension of the second portion, and the first dimension of the business card are aligned such that when the business card is affixed to the first portion by the adhesive, the customized magnetic advertisement presented by the first and second portions has a professional, finished appearance; and

issuing the magnetic advertisement with affixed business card to current or prospective clients or customers.

34. (Cancelled)

35. (Cancelled).

36. The method of claim 33 wherein providing the second portion includes providing a coupon, the method further comprising:

presenting the coupon to the issuer of the coupon; and

redeeming the coupon in exchange for one of a free product, a free service, a discounted product, and a discounted service.

37. The method of magnetic advertising of claim 33 wherein the first layer includes a boundary between the first portion and the second portion, the boundary included one of perforations, indentations, or scoring to aid in the separation of the first portion from the second portion and further.

38. The method of magnetic advertising of claim 37 wherein the second portion includes a coupon the method further comprising:

- separating the first and second portions;
- presenting the coupon to the issuer of the coupon; and
- redeeming the coupon for in exchange for one of a free product, a free service, a discounted product, or a discounted service.

39. The method of magnetic advertising of claim 33 wherein providing the second portion includes providing a service reminder, the method further comprising configuring the service reminder to indicate when to seek service, and presenting the service reminder to a customer with the business card affixed.

40. The method of magnetic advertising of claim 33 wherein the second portion includes an appointment reminder.

41. The method of magnetic advertising of claim 33 wherein the second portion includes a tag line including information about the business.

42. The method of magnetic advertising of claim 33 further comprising writing information on the second portion.

43. The method of magnetic advertising of claim 33 further comprising writing information in designated areas of the second portion.

44. The method of magnetic advertising of claim 43 wherein the written information includes one of an appointment, a date and a time.
45. The magnetic advertising of claim 43 wherein the written information includes a service to be performed.
46. The method of magnetic advertising of claim 43 wherein the written information includes one of a make, a model, and one or more services to be performed on a vehicle.
47. The method of magnetic advertising of claim 33 further comprising placing the second surface in contact with a magnetic receptive material to display the advertisement.
48. The method of magnetic advertising of claim 33 wherein the magnetic layer is formed in a shape identified with a business.
49. The method of magnetic advertising of claim 33 wherein the first and second dimensions of the first portion of the first surface are substantially three and a half inches by two inches.